

**REMARKS**

The applicant has carefully considered the official action dated April 26, 2005, and the references it cites. Claims 1-11 are pending and at issue, of these, claims 1, 5, and 9 are independent. Claims 1, 5, and 9-11 have been amended to remove "step of" language. No new matter has been added and the amendments have not been made for reasons of patentability. In view of the following remarks, the applicant respectfully submits that pending claims 1-11 are in condition for allowance. The applicant respectfully requests reconsideration of this application.

**The Rejections under 35 U.S.C. § 102**

Claims 5, 6, and 8-11 were rejected under 35 U.S.C. § 102(e) as anticipated by DeBruin-Ashton. The applicant respectfully submits that because DeBruin-Ashton does not disclose or suggest attaching first and second printed brochure versions to respective copies of a periodical, as recited in independent claims 5 and 9, claims 5, 6, and 8-11 are allowable over the cited art.

**Claims 5-8**

Independent claim 5 recites, *inter alia*, a method of targeting promotions to individual subscribers of a periodical, including attaching first and second printed brochure versions to respective copies of a periodical. In other words, the respective printed brochure and the periodical are independent entities that are attached to one another after the brochure is printed. DeBruin-Ashton does not disclose attaching first and second printed brochure versions to respective copies of a periodical.

The examiner contends that electronically merging variable print information and photographs with a directory template to form the directories (column 13, lines 39-43) constitutes attaching a printed brochure to a respective periodical as recited in claim 5.

However, the examiner's contention ignores the language set forth in claim 5 that requires attaching a printed brochure to a respective periodical. Instead, the examiner has incorrectly construed an electronic merging of data as taught by DeBruin-Ashton to be the same as attaching a printed brochure to a respective printed periodical as recited in claim 5. One of ordinary skill in the art will readily appreciate that electronically merging data cannot be construed to mean attaching a printed physical structure to another physical structure, because electronic data is not the same as printed information.

Further, DeBruin-Ashton does not disclose or even suggest printed brochure versions independent of respective periodicals, much less attaching the printed brochure versions to respective periodicals as recited in claim 5. Any suggestion that DeBruin-Ashton discloses or suggests printing a brochure independent of a periodical, and attaching the printed brochure to the periodical is completely unfounded. Instead, DeBruin-Ashton discloses electronically merging the directory template and variable print information (e.g., physician names, photographs, maps, etc.), which are then printed to form a printed directory. (col. 13, lines 39-43). In other words, DeBruin-Ashton discloses first electronically merging information and then printing all of the information including the variable print information the photographs and maps as part of the directory and, thus, does not disclose printing a brochure independent of the directory. Moreover, DeBruin-Ashton discloses that the entire directory is a brochure (column 10, lines 40-42), which is contrary to the examiner's apparent contention that DeBruin-Ashton discloses attaching a printed brochure to a periodical as recited in claim 5.

Therefore, due to the deficiencies in DeBruin-Ashton, it follows that DeBruin-Ashton cannot anticipate claim 5 or any claims dependent thereon. In particular, because DeBruin-Ashton does not disclose or suggest attaching first and second printed brochure versions to respective copies of a periodical, DeBruin-Ashton cannot anticipate claims 5-8. Accordingly,

for at least the foregoing reasons, the applicant respectfully submits that claims 5-8 are in condition for allowance.

**Claims 9-11**

Independent claim 9 similarly recites attaching the first and second printed brochure versions to respective copies of the periodical. Therefore, independent claim 9 is also allowable over the art of record for at least the reasons set forth above in connection with claim 5. Accordingly, for at least those reasons, the applicant respectfully submits that claims 9-11 are in condition for allowance.

**The Rejections under 35 U.S.C. § 103**

Claims 1, 2, and 4 were rejected under 35 U.S.C. § 103(a) as unpatentable over DeBruin-Ashton, and claims 3 and 7 were rejected under 35 U.S.C. § 103(a) as unpatentable over DeBruin-Ashton in view of Manley, et al. The applicant respectfully submits that all claims are allowable over the cited art for the reasons set forth below.

**Claims 1-4**

Independent claim 1 is directed to a method of creating a brochure, and recites, *inter alia*, creating a first brochure version template and a second brochure version template. The examiner contends that in light of DeBruin-Ashton one of ordinary skill in the art would have been motivated at the time the invention was made to generate and store more than one template in a template directory. As stated in the Office action, the examiner admits that DeBruin-Ashton does not disclose creating a second brochure version template (i.e., more than one template).

It is well established that motivation to modify references may be drawn from the nature of the problem to be solved, the cited references, or the knowledge of persons of ordinary skill in the art. (MPEP § 2143.01). The applicant respectfully submits that, at the

time the invention was made, one of ordinary skill in the art would not have been motivated to create more than one template based on DeBruin-Ashton, the nature of the problem to be solved by DeBruin-Ashton, or the knowledge of persons of ordinary skill in the art. In particular, the examiner contends that one of ordinary skill in the art would have been motivated to create more than one template in view of DeBruin-Ashton's teachings of generating lists of medical professionals, each having varying fields of information.

However, instead of suggesting creating a plurality of directory templates, DeBruin-Ashton actually teaches accommodating various combinations of physician listings by creating one template having variable fields and inserting physician information in the variable fields based on customer-specific information to customize and print physician directories for each recipient. Specifically, in light of DeBruin-Ashton one of ordinary skill in the art would be motivated to create only one template that is configured to receive variable information, and repeatedly run the same directory template through the same sequence of customization operations (FIGS. 2A-2C) for each subscriber.

Further, in light of DeBruin-Ashton one of ordinary skill in the art would be motivated to create only one template because DeBruin-Ashton teaches and suggests the elimination of more than one template by creating a template capable of accepting different amounts of information (e.g., different number of physician listings). (col. 8, lines 36-55; col. 11, lines 36-41 and 55-59; col. 12, lines 32-36). Specifically, although DeBruin-Ashton recognizes that, in some cases, the computer system (100) will be able to gather more or less physician listings for some directories than other directories, DeBruin-Ashton recognizes that such inconsistencies in numbers of physician listings from directory to directory can be addressed by using one template in combination with threshold values that indicate the number of physician names that must be gathered for each directory.

Accordingly, in light of the teachings of DeBruin-Ashton one of ordinary skill in the art would not be motivated to modify DeBruin-Ashton to create first and second templates as recited in claim 1 because DeBruin-Ashton discloses a manner in which to avoid creating more than one template by using a physician directory printing process adapted to use one template regardless of the amount of information that can be gathered for each physician directory.

Therefore, for at least the foregoing reasons, one of ordinary skill in the art would not be motivated to make the modification to DeBruin-Ashton as suggested by the examiner, and it follows that the cited art cannot render obvious independent claim 1 or claims 2-4 dependent thereon. Accordingly, the examiner has failed to show a prima facie case of obviousness, and the applicant respectfully submits that independent claim 1 and claims 2-4 dependent thereon are in condition for allowance.

**Claims 3 and 7**

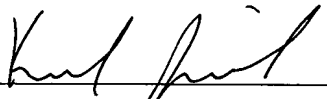
The applicant respectfully submits that because independent claim 1 is in condition for allowance, claim 3 dependent thereon is also in condition for allowance. The applicant also respectfully submits that because independent claim 5 is in condition for allowance, claim 7 dependent thereon is also in condition for allowance.

**Conclusion**

As noted earlier, claims 1, 5, and 9-11 have been amended to eliminate "step of" language to make it clear that such claims are not to be construed under 35 U.S.C. § 112, ¶ 6. Such amendments are not narrowing and are not made for reasons related to patentability.

The applicant respectfully requests reconsideration of the application and allowance thereof. If there is any matter that the examiner would like to discuss, the examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,



Keith R. Jarosik  
Registration No. 47,683  
Attorney for Applicant  
Hanley, Flight & Zimmerman, LLC  
(at customer number 34431)  
20 North Wacker Drive  
Suite 4220  
Chicago, Illinois 60606  
312.580.1020

DATE: 7/26/05